

Remarks

This communication responds to the Office Action mailed May 14, 2009 for the application captioned above. By this amendment, claim 1 is amended and new claims 30-33 are submitted. Applicant respectfully requests entry and examination of new claims 30-33, support for which may be found in the application as originally filed, for example, in paragraphs [0007]-[0016], [0065] and [0078] of the publication thereof (US 2004/0260310 A1). No new matter has been added as a result of this amendment. The following remarks are respectfully submitted.

§103 Rejection

Claims 1, 3, 4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Putz (US 4,903,702). Applicant respectfully traverses the rejection of claims 1, 3, 4 and 6-9, based upon the arguments presented below.

Applicant respectfully asserts that Putz neither teaches nor suggests all the limitations of claims 1, 3, 4 and 6-9 and that the disclosure of Putz is not sufficient to render the claims *prima facie* obvious.

In response to Applicant's prior remarks, which were filed on April 16, 2009, the Examiner reiterates that it would have been obvious to one having ordinary skill in the art to have modified Putz to include an orientation marker displaced from a center line. However, the Examiner has not addressed Applicant's assertion that Putz teaches away from an orientation marker that is displaced from an electrode array, as is the orientation marker of claim 1 of the present application. Nor has the Examiner addressed Applicant's assertion that the disclosure of Putz is not sufficient to render the claims *prima facie* obvious, per the MPEP, section 2143.01, paragraphs V and VI, since by modifying Putz to displace any of the markers 34 from the corresponding contact 20 one would render the invention of Putz unsatisfactory for its intended purpose and/or would change the principle of operation, from that taught by Putz, when an implanter implants the strip electrode 10 or the grip electrode 11/14 of Putz. Applicant respectfully directs the Examiner's attention back to the remarks filed in the response of April

16, 2009, in which Applicant has cited specific passages from Putz as objective evidence to support these assertions, and respectfully requests that the Examiner address these remarks, if she sustains the present rejection.

Furthermore, Applicant respectfully asserts Putz neither teaches nor suggests a medical lead that is configured for electrical stimulation of a spinal cord, like that defined by claim 1 of the present application, wherein an electrode array is displaced from a proximal end of a paddle such that a portion of the paddle, which is free of electrodes, extends proximally from the electrode array over a length of at least 40 mm. Rather, Putz discloses configurations of a subdural strip electrode 10, or grid electrodes 12, 14, for brain contact devices, each of which have a plurality of contacts 20 (electrode array), in which one or more of the contacts 20 is positioned in relatively close proximity to a proximal edge 24 of the corresponding strip 18 (paddle), as can be seen in Figures 1-5 of Putz. The Examiner has asserted that Putz is silent about a length of an electrode free portion of a paddle. Applicant respectfully disagrees - although Putz does not specify a particular length between the proximal edge 24 and the most proximal contact, it is evident from the disclosure of Putz that the length is significantly shorter than 40 mm or 1 ½ inches. In addition to the evidence of the aforementioned Figures, Applicant respectfully directs the Examiner's attention to column 5, lines 14 and 15, of Putz, where sheathing 38 is described as being secured to the proximal edge 24, and to lines 41-51 of the same column, where the intent of Putz to position contact(s) 20 in close proximity to the proximal edge 24 is made clear. Here Putz discloses that a determination of intracranial positions of contacts 20, by x-ray, is greatly facilitated by radiopaque dielectric marker ring 34 against distal contact 36 **and** radiopaque dielectric sheathing 38 extending from the proximal edge 24 of the strip 18; Putz goes on to state that "viewing the positions of radiopaque dielectric ring 34 and radiopaque sheathing 38 provides precise knowledge of the positions of each of contacts 20 along strip 10." Such precise knowledge would not be provided if the most proximal contact 20 were significantly displaced from the proximal edge 24, for example, by a length of 40 mm or more. Thus, the disclosure of Putz is again insufficient to render the claims of the present application *prima facie* obvious, per the MPEP, section 2143.01, since modifying Putz to

displace the most proximal contact(s) 20 from the proximal edge 24, so that a portion of the strip 18 that is free of contacts 20 extends proximally to the edge 24 over a length that is at least 40 mm, would render the invention of Putz unsatisfactory for its intended purpose.

Finally, Applicant respectfully directs the Examiner's attention to paragraph [0007] of the publication of the present application (US 2004/0260310 A1), where a significance of the displacement of the electrode array, according to the embodiment that is defined by claim 1, is described.

In light of the arguments presented above, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 3, 4 and 6-9.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested. Applicant believes no fee is due to enter the present Amendment. The Commissioner is hereby authorized to charge any additional filing fees required to Deposit Account No. 061910. The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

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/Elisabeth Lacy Belden/
Elisabeth Lacy Belden
Reg. No. 50,751
(612) 492-7843

Fredrikson & Byron, P.A.
200 South Sixth Street, Suite 4000
Minneapolis, MN 55402-1425 USA
Facsimile: (612) 492-7077